

Notice of Allowability

Application No.

10/766,691

Applicant(s)

DONOHO ET AL.

Examiner

Maryam Monshipouri

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to ____.
2. ☒ The allowed claim(s) is/are 5.
3. ☐ The drawings filed on ____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date ____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date filed <u>1/28/04</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other ____. |

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 4, drawn to isolated DNA sequences encoding human kinases, classified in class 536, subclass 23.2.
- II. Claim 5, drawn to isolated human kinases, classified in class 530, subclass 350.
- III. Claim 6, drawn to antibodies which specifically bind said kinases, classified in class 530, subclass 387.9.

In addition to Groups I-III above, Group I invention is directed to the following 4 inventions (see inventions 1-4 below) of unrelated chemical structure and function and Groups II-III are each independently directed to the following 5 (see inventions 1-5 below) patentably distinct inventions of unrelated chemical structure and function:

- (1) SEQ ID NO:2 or DNA encoding it.
- (2) SEQ ID NO:4 or DNA encoding it.
- (3) SEQ ID NO:6 or DNA encoding it.
- (4) SEQ ID NO:8 or DNA encoding it.
- (5) SEQ ID NO:10 and 12 or DNA encoding them.

Applicant is advised to elect one invention from groups I-III and one invention from groups 1-4 or 1-5 above simultaneously, in response to this office action.

The inventions are distinct, each from the other because of the following reasons:
The inventions of Groups I-III are patentably distinct each from the other because each invention is directed to a product of unrelated chemical structure and function.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. David Hibler on 4/22/05 a provisional election was made without traverse to prosecute the invention of Group II (SEQ ID NO:10 and 12), claim 5. Affirmation of this election was made by applicant in this Office action. Claims 4 and 6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization of this examiner's amendment was given By Mr. David Hibler on 5/6/2005.

Examiner's Amendment to the Claims

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This application is in condition for allowance except for the presence of claims 4-6, SEQ ID NO: 2, 4, 6, 8 drawn to non-elected inventions without traverse. Accordingly, claims 4 and 6 have been cancelled.

Cancel claims 4 and 6.

In claim 5, lines 1-2, after "SEQ ID NO:", delete "2, 4, 6, 8, ".

Examiner's Amendments to the Specification

Amend the first full paragraph on page 1, beginning with " The present application ...", as follows:

The present application is a continuation of co-pending U.S. Application Number 09/671,050 filed September 27, 2000, now U.S. Patent No. 6,716,616, issued April 6, 2004, which claims the benefit of U.S. provisional Application Number 60/156,511 which was filed on September 28, 1999, both of which are herein incorporated by reference in their entirety.

The following is an **Examiner's Statement of Reasons for Allowance**:

Claim 5 (SEQ ID NO:10 and 12) are directed to human kinases of specific amino acid sequence. Claimed amino acid sequences are free of prior art. Further, the prior art does not teach or suggest preparing such specifically claimed amino acid sequences. Hence, said sequences are also non-obvious.

Claim 5 is allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

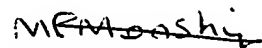
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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose telephone number is (571) 272-0932. The examiner can normally be reached on 7:00 a.m to 4:30 p.m. except for alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnanthapu Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Maryam Monshipouri Ph.D.

Primary Examiner